

## REMARKS

Applicant has studied the Office Action dated October 5, 2006. Claims 1, 3-6 and 23-45 are pending. Claims 3, 5 and 6 have been amended and claims 2, 7 and 8 have been canceled without prejudice. New claims 9-13 have been added. Claims 1, 6, 9 and 13 are independent claims. No new matter has been added as the amendments have support in the specification as originally filed.

It is submitted that the application, as amended is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### Amendments to Specification

An amendment has been made to the specification at page 1 in order to claim priority to the foreign application

### Claim for Foreign Priority under 35 U.S.C. § 119

The Examiner acknowledged the Applicant's claim for foreign priority under 35 U.S.C. § 119 and indicated that a certified copy of the priority document had been received.

### Amendments to the Claims

Claims 2, and 5 have been amended to correct typographical or grammatical errors or to more clearly disclose the invention. It is respectfully submitted that the amendments have support in the application as originally filed and are not related to patentability.

### § 112 Rejections

The Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Examiner asserted that the phrase "and the like" in the claim includes elements not actually disclosed, thereby rendering the scope of the claim unascertainable.

With this paper, claim 3 has been amended to delete the phrase "and the like." It is respectfully asserted that the grounds for the rejection have been overcome and it is respectfully requested that the rejection be withdrawn.

#### § 102 Rejections

Claims 1, 4, 5, 6 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Schader et al. ("Schrader" App. Pub. No. 2002/0166123). Applicant respectfully traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With this paper, claim 7 has been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claim 7 and it is respectfully requested that the rejection be withdrawn.

With this paper, claims 1 and 6 have been amended to incorporate the limitations of, respectively, claim 2 and claims 7 and 8, which have been canceled without prejudice, and further amended to more clearly disclose the present invention by reciting a preference that is one of directly inputted by a user and automatically created from a watch record based upon specific digital broadcasts previously accessed by the user. It is respectfully submitted that Schrader fails to disclose this limitation

It is respectfully noted that the Examiner indicates, at paragraph 9 on pages 7 and 8 of the Office action with respect to claims 2 and 8, that Schrader does not explicitly teach "preference extracting means for extracting a preference that is directly inputted by a user or that is automatically created from a watch record" or "the user preference is ... automatically created from a user's watch record." Therefore, it is

respectfully asserted that independent claims 1 and 6 are allowable over the cited reference, as are claims 4 and 5, which depend from claim 1.

It is further respectfully noted that the Examiner indicates, at paragraph 9 on pages 7 and 8 of the Office action with respect to claims 2 and 8, that the Brontz et al. reference cures the indicated deficiencies of Schrader. The Brontz et al. reference will be discussed with regard to the 35 U.S.C. § 103 rejections, as they apply to amended claims 1 and 6.

### § 103 Rejections

Claims 2 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schader in view of Brontz et al. ("Brontz" U.S. Pat. App. Pub. No. 2006/0161961). Applicant respectfully disagrees with the Examiner's interpretation of Brontz and respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte

Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

It is well-settled law that to support a finding of obviousness, a reference must provide some motivation, working without the benefit of the applicant's specification, to make the necessary changes in the device disclosed in the reference. The mere fact that a worker in the art could modify the reference to meet the terms of the claims is not, by itself, sufficient. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

With this paper, claims 2 and 8 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 2 and 8 and it is respectfully requested that the rejection be withdrawn.

With respect to claims 2 and 8, the limitations of which have been incorporated into independent claims 1 and 6, it is respectfully noted that the Examiner asserts, at paragraph 9 on pages 7 and 8 of the Office action, that Brontz \_\_\_\_\_ indicated deficiencies of Schrader with respect to "preference extracting means for extracting a preference that is directly inputted by a user or that is automatically created from a watch record" and "the user preference ... is automatically created from a user's watch record." Applicant respectfully submits that the teachings of Brontz would not motivate one of ordinary skill in the art to modify the Schrader invention to produce the present invention.

It is respectfully noted that the Brontz invention is directed to a "efficiently accessing and displaying viewer-selected web pages and other HTML documents to a viewer." Paragraph 0009. It is further respectfully noted that the disclosure in Brontz is directed solely to hypertext documents, HTML-based media and documents and web pages. See, for example, paragraphs 0010-0013, 0028, 0035, 0042-0053 and 0060. On the other hand, it is respectfully noted that the Schrader invention, which the

Examiner seeks to modify with the teachings of Brontz, is directed to "Digital Video Recording (DVR) and playback services and systems." Paragraph 0002.

It is respectfully submitted that one of ordinary skill in the art would **not** be motivated by the teachings of Brontz related to "efficiently accessing and displaying viewer-selected web pages and other HTML documents to a viewer" to modify the Schrader invention directed to "Digital Video Recording (DVR) and playback services and systems" to produce the present invention that recites "preference extracting means for extracting a preference that is directly inputted by a user or that is automatically created from a watch record" and "the user preference ... is automatically created from a user's watch record." It is further respectfully submitted that one of ordinary skill in the art would have to rely on impermissible hindsight regarding the present claims to find the requisite motivation to modify the Schrader invention by the teachings of Brontz.

Therefore, it is respectfully asserted that the combination of the Schrader and Brontz references is improper. It is respectfully requested that the claims 1 and 6 are allowable over the cited combination of references.

Notwithstanding that the combination of Schrader and Brontz is improper, it is respectfully submitted that the additional recitation in independent claims 1 and 6 of a preference that is automatically created from a watch record based upon specific digital broadcasts previously accessed by the user further differentiates the present claims from the teachings of Brontz. It is further respectfully submitted that even if the Schrader invention were modified by the teachings of Brontz, the resulting invention would not anticipate the present claims.

It is respectfully noted that the Examiner, at paragraph 9 on pages 7 and 8 of the Office action specifically, cites paragraph 0011 of Brontz as curing the deficiencies of Schrader with respect to "preference extracting means for extracting a preference that is directly inputted by a user or that is automatically created from a watch record" and "the user preference ... is automatically created from a user's watch record." It is further respectfully noted the Examiner specifically asserts the disclosure that "the intelligent filter modifies itself based upon user behavior ... and user preferences in terms of the web pages that a viewer routinely visits" by "identify[ing] certain web pages

(or other HTML-based documents and multi-media components) of the data that are being broadcast."

It is respectfully submitted that a thorough reading shows that nowhere in Brontz is it disclosed to base preferences upon specific digital broadcasts previously accessed by the user, as is recited in amended independent claims 1 and 6. It is further respectfully submitted that the "web pages (or other HTML-based documents and multi-media components) of the data that are being broadcast" of Brontz are patentably different from the digital broadcasts recited in claims 1 and 6 such that one of ordinary skill in the art would not modify the Schrader invention in a manner that would produce the present invention. Therefore, it is respectfully asserted that claims 1 and 6 are allowable over the cited combination of references.

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schrader in view of Koreeda et al. ("Koreeda" U.S. Pat. App. Pub. No. 2002/0019979). Applicant respectfully traverses the rejection.

It is respectfully submitted that Koreeda fails to cure the deficiencies of Schrader with regard to a preference that is automatically created from a watch record based upon specific digital broadcasts previously accessed by the user, as recited in independent claim 1. Therefore, it is respectfully asserted that claim 1 is allowable over the cited combination of references, as is claim 3, which depends from claim 1.

### New Claims

With this paper, new claims 9-13 have been added. It is respectfully asserted that the claims, which recited limitations similar to those of claims 1 and 3-6, are allowable for the same reasons given herein with regard to claims 1 and 3-6.

### CONCLUSION

In view of the above remarks, Applicant submits that claims 1, 3-6 and 9-13 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: January 3, 2007

By: 

Richard C. Salfelder  
Registration No. 51,127  
Attorney for Applicant

Customer No. 035884